

REMARKS

The present Amendment is fully responsive to the Office Action having a mailing date of August 5, 2008 (the "Office Action"). After entry of this Amendment, claims 28, 30-35, 37-43, 45, 47, 48, 50, 51, 53, 55, 56, and 58-72 are pending in the Application. Claims 28, 32, 34, 45, 47, 48, 56, 58, 64, 65 and 67 have been amended. Claims 46, 49, 52 and 54 have been cancelled without prejudice. New claims 69-72 have been added. No new matter has been added by this Amendment and support for the claims, as amended and added, may be found throughout the specification and drawings. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers.¹ Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully requests that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

Applicant respectfully requests reconsideration of the present Application in view of the above amendments, the new claims, and the following remarks.

General Statement

In the Office Action the Examiner identifies multiple passages within the pending claims alleged to be functional recitations. The Examiner identifies the purported functional language by enclosing the same within brackets in the Office Action (*see* pg. 11 of the Office Action). The Examiner states that "while features of an apparatus may be recited either structurally or functionally, claims directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function." (*See* pp. 11-12 of the Office Action, citing MPEP 2114). The Examiner further states that "[t]he reference discloses all of the claimed structural limitations and

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future.

therefore anticipates the claims.” The Examiner appears to mistakenly take the position that functional language does not need to be considered when determining patentability. To the contrary, MPEP 2173.01 provides that an “[a]pplicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought [emphasis added].” “There is nothing inherently wrong with defining some part of an invention in functional terms.” (MPEP 2173.05(g), citing *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)). “Functional language does not, in and of itself, render a claim improper.” *Id.* More importantly, “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context of which it is used.” MPEP 2173.05(g). It is clear that functional language must be considered, as a minimum, when it sets “definite boundaries on the patent protection sought.” *Id.*

Indeed, functional language can be useful to more precisely define the physical relationship between interrelated components. For example, MPEP 2173.05(g) describes a case in which claims are directed to a kit of components capable of being assembled. “[T]he Court held that limitations such as ‘members adapted to be positioned’ and ‘portions ... being resiliently dilatable whereby said housing may be slidably positioned’ serve to precisely define present structural attributes of interrelated component parts of the claimed assembly [emphasis added].” *Id.*

It is abundantly clear that functional language cannot be arbitrarily disregarded. Applicant recognizes that when claiming subject matter in terms of function, property or characteristic, there may be grounds for a rejection under either 35 U.S.C. §§ 102 or 103 if the subject matter of the prior art is the same as that of the claim, although the function is not explicitly disclosed in the reference, provided the function is necessarily an inherent characteristic of the prior art device. (*See* USPTO Patent Examination Policy, 35 U.S.C. 112 Rejections Not Based on Prior Art, section entitled “Functional Limitations – MPEP 2114, 2173.05(g) and 2181”). However, when relying upon the theory of inherency, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art [emphasis in original].” *Id.*, citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Board in *Levy* “reversed the examiner’s

rejection because the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.” *Id.*

In the present Office Action, the Examiner makes an unsubstantiated assertion that “the apparatus [described in the cited reference] is capable of performing the claimed functions” without providing any evidence whatsoever, either in fact or technical reasoning, for arriving at such a conclusion. If the Examiner intends to maintain the rejection of claims allegedly reciting functional language, Applicant respectfully requests that the Examiner provide objective evidence or technical reasoning to support the Examiner’s assertion that the cited reference is capable of performing the claimed functions, or otherwise withdraw the rejections.

Claim Rejections – 35 U.S.C. § 112

Claims 65 and 67 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The rejection is respectfully traversed.

A. Claim 65

The Examiner states that it unclear what displaces the “second element” as recited in claim 65. The Examiner further alleges that use of the term “when” renders the claim unclear. The rejection is respectfully traversed. There is no requirement that a claim itself be enabling. Only the specification need be enabling. An applicant need only claim subject matter which is deemed to be novel. Nevertheless, for purposes of advancing prosecution Applicant has rewritten claim 65 to depend from new claim 69, and to further recite that “said second element is displaced axially along a longitudinal length of said lever when said lever is pivoted to at least one of said first and second positions.” Accordingly, it is respectfully requested the rejection under 35 U.S.C. § 112 with respect to claim 65 be reconsidered and withdrawn.

B. Claim 67

The Examiner contends that it is unclear how an element can be “selectively” engaged. The term “selectively engages” (as recited in claim 67) is commonly used to indicate that the components are capable of being engaged and disengaged. In other words, the components are not

fixedly or permanently coupled to one another. The term is used to more precisely describe the interconnection between the components. Nevertheless, in the interest of advancing prosecution, claim 67 has been rewritten to depend from new claim 69 and to recite that the “second element selectively engages said third element when said lever is pivoted to one of the first and second positions.” Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 112 with respect to claim 67 be reconsidered and withdrawn.

Claim Rejections – 35 U.S.C. § 102

In the Office Action, claims 28, 30-35, 37-43, 45-54, 56, 58-62, and 64-68, stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Blood et al. (US 1,780,898) (hereinafter “Blood”). The rejection is deemed moot with respect to claims 46, 49, 52 and 54, which have herein been cancelled without prejudice. Applicant respectfully traverses the rejection for at least the following reasons.

A. Independent Claim 28

The rejection with respect to claim 28 is respectfully traversed. Notwithstanding, claim 28 has been rewritten to recite that “said first element is disposed between said pivoting member and said second element ... [and] said second element [is] disposed between said first element and said biasing element”. In contrast, Blood does not anticipate, teach, or suggest the claimed combination of elements.

The Examiner contends that ring member (5) of Blood corresponds to the “first element” of claim 28 (page 3 of the Office Action); hood (4) corresponds to the “second element”; the washer positioned atop of transmission casing cover (1) (identified by reference character “B” in the figure on page 4 of the Office Action) corresponds to the “third element”; and the spring positioned between the washer and ring member (5) (identified by reference character “C” in the figure on page 4 of the Office Action) corresponds to the “biasing element”. However, hood (4) of Blood (which allegedly corresponds to the “second element” in claim 28) is not described as being disposed between ring member (5) (which allegedly corresponds to the “first element” of claim 28) and the spring, as recited in claim 28. Rather, ring member (5) is shown disposed between hood (4) and the spring. Further, the deficiency cannot be eliminated by referring to hood (4) as the “first element”

and ring member (5) as the “second element”, since ring member (5) will not be disposed between hood (4) and the spring, as recited in claim 28. Accordingly, it is respectfully submitted that Blood does not disclose the “first element” disposed between the “pivoting member” and the “second element”, and the “second element” disposed between the “first element” and the “biasing element”.

Claim 28 has also been rewritten to recite that the “third element [is] axially fixed to said lever relative to said longitudinal axis [of the lever].” The Examiner contends that the washer shown engaging the top of transmission casing cover (1) in Blood (identified by reference character “B” in the figure on page 4 of the Office Action) corresponds to the “third element” of claim 28. It is apparent from Figs. 1 and 2 of Blood that, in contrast to claim 28, the washer slidably engages lever (2) rather than being fixedly attached. This is due to the fact that the surface on which the washer sits (consisting of an end surface of transmission casing cover (1) and the member the Examiner refers to as a “pivoting member”) is configured as a flat surface. The washer is held in contact with the flat surface by the spring positioned between the washer and ring member (5). Affixing the washer to lever (2) will result in the washer traveling in an arch as lever (2) is pivoted. To prevent the top surface of the housing/pivoting member from interfering with the movement of the washer, the top surface would necessarily have to have a convex shape, which it does not. Since the top surface of the housing/pivoting member is shown configured as a flat surface, the washer must either have a large enough clearance between its inner diameter and the outer diameter of lever (2) to allow for pivoting of lever (2), which it does not, or the washer must be capable of being slid axially along the length of the lever as the lever is pivoted. Either way, it is apparent the washer cannot be fixedly attached to lever (2), as the Examiner contends. Accordingly, it is respectfully submitted that Blood does not disclose a “third element axially fixed to said lever relative to said longitudinal axis”, as recited in claim 28.

B. Dependent Claims 30-35, 37-42, and 45-54

Claims 30-35, 37-43, 45, 48, 49, 50, 51-55, and 65-67, depend either directly or indirectly from claim 28, and are therefore in a condition for allowance for the same reasons as set forth above with respect to claim 28. Nevertheless, these dependent claims also recite independently patentable subject matter.

For example, claim 30 recites in part that “said biasing member is operable to bias said lever into at least one biased neutral position.” Claim 33 provides that the “biasing member applies a biasing force operable to oppose displacement of said lever in any direction.” The examiner contends that the “biasing member” in Blood consists of the ring member (5), hood (4), the washer positioned atop transmission casing cover (1), and the spring positioned between the washer and ring member (5). However, the identified components, either individually or in combination, do not operate to bias shift lever (2) into the positions recited in claims 30 and 33. Rather, the spring provides a biasing force for retracting sleeve member (10) from slot (17), thereby unlocking the shifting mechanism. (See Blood, Figs. 1 and 2, text at pg. 1, lines 72-100 and pg. 2, lines 1-43). The spring provides a biasing force for urging ring member (5) and hood (4) away from transmission casing cover (1). Ring member (5) is connected to sleeve member (10) by means of rod (8). Movement of hood (4) produces a corresponding movement of sleeve member (10). The spring operates to bias sleeve member (10) into the unlocked position. Accordingly, the alleged “biasing member” does not operate to bias lever (2) into the positions as recited in claims 30 and 33.

Claim 39 recites in part that the “first element is adapted to engage with a stop means.” The Examiner contends that ring member (5) of Blood corresponds to the “first member” of claim 39, and that the stop mean corresponds to the feature identified by reference character “D” in the figure on page 4 of the Office Action. However, contrary to the Examiner’s assertion, feature “D” is not shown engaging ring member (5). Moreover, it appears to be virtually impossible for the two features to contact one another. Thus, Blood fails to disclose the “first element” engaging a “stop means”, as recited claim 39.

C. Independent Claim 47

Claim 47 has been rewritten into dependent form to depend from claim 28, and is therefore in a condition for allowance for the same reasons as set forth above with respect to claim 28.

D. Independent Claim 56

The rejection with respect to claim 56 is respectfully traversed. Notwithstanding, claim 56 has been rewritten to recite that the “pivoting member [is] slidably disposed in said retaining cup.” In contrast, Blood does not anticipate, teach, or suggest the claimed combination of elements.

The Examiner contends that the feature identified by reference character “A” in the figure shown on page 4 of the Office Action corresponds to the “pivoting member” of claim 56. The Examiner further states that the upper end of transmission casing cover (1), in which the alleged “pivoting member” is disposed (identified by reference character “H” in the figure on page 4 of the Office Action), corresponds to the “retaining cup” of claim 56. The alleged “pivoting member” of Blood, however, is not slidably disposed within the “retaining cup”. The upper end of the alleged “pivoting member” in Blood has a frustoconical shape with liner sides that fit within a correspondingly shaped pocket in transmission casing cover (1). The “pivoting member” is retained in the pocket by a spring. The non-spherical outer contour of the alleged “pivoting member” in Blood prevents it from sliding within the “retaining cup” when lever (2) is pivoted. Accordingly, it is respectfully submitted that Blood does not disclose a “pivoting member slidably disposed” within a “retaining cup”.

The Examiner contends that ring member (5) of Blood corresponds to the “first element” of claim 56 (page 8 of the Office Action); hood (4) corresponds to the “second element”; the washer positioned atop of transmission casing cover (1) (identified by reference character “B” in the figure on page 4 of the Office Action) corresponds to the “third element”; and the spring positioned between the washer and ring member (5) (identified by reference character “C” in the figure on page 4 of the Office Action) corresponds to the “biasing element”. However, hood (4) of Blood (which allegedly corresponds to the “second element” in claim 56) is not described as being disposed between ring member (5) (which allegedly corresponds to the “first element” of claim 56) and the spring, as recited in claim 56. Rather, ring member (5) is shown disposed between hood (4) and the spring. Further, the deficiency cannot be eliminated by referring to hood (4) as the “first element” and ring member (5) as the “second element”, since ring member (5) will not be disposed between hood (4) and the spring, as recited in claim 56. Accordingly, it is respectfully submitted that Blood

does not disclose the “first element” disposed between the “pivoting member” and the “second element”, and the “second element” disposed between the “first element” and the “biasing element”.

Claim 56 has also been rewritten to recite that the “third element [is] fixed relative to said lever”. The Examiner contends that the washer shown engaging the top of transmission casing cover (1) in Blood (identified by reference character “B” in the figure on page 4 of the Office Action) corresponds to the “third element” of claim 56. It is apparent from Figs. 1 and 2 of Blood that, in contrast to claim 56, the washer slidably engages lever (2) rather than being fixed relative to the lever. This is due to the fact that the surface on which the washer sits (consisting of an end surface of transmission casing cover (1) and the member that the Examiner refers to as a “pivoting member”) is configured as a flat surface. The washer is held in contact with the flat surface by the spring positioned between the washer and ring member (5). Affixing the washer to lever (2) would result in the washer traveling in an arch as lever (2) is pivoted. To prevent the top surface of the housing/pivoting member from interfering with the movement of the washer, the surface would necessarily have to have a convex shape, which it does not. Since the top surface of the housing/pivoting member is shown configured as a flat surface, the washer must either have a large enough clearance between its inner diameter and the outer diameter of lever (2) to allow for pivoting of lever (2), which it does not, or the washer must be capable of being slid axially along the length of the lever as the lever is pivoted. Either way, it is apparent that the washer cannot be fixedly attached to lever (2), as the Examiner contends. Accordingly, it is respectfully submitted that Blood does not disclose a “third element fixed relative to said lever”, as recited in claim 56.

E. Dependent Claims 58-62 and 68

Claims 58-62 and 68 depend either directly or indirectly from claim 56, and are therefore in a condition for allowance for all the same reasons as set forth above with respect to claim 56.

Applicant accordingly requests that the instant rejection under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, dependent claims 55 and 63 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Blood, as applied to claims 28 and 56, and further in view of Kessmar (US 4,104,929) (hereinafter “Kessmar”). Applicant respectfully traverses the rejection. The cited references, whether taken singularly or in any permissible combination, do not anticipate, teach, or suggest the subject matter of pending claims 55 and 63. As discussed above with respect to independent claims 28 and 56, from which claims 55 and 63 depend either directly or indirectly, Blood does not disclose a “first element” disposed between a “pivoting member” and a “second element”, and the “second element” disposed between the “first element” and a “biasing element”. Further, Blood does not disclose a “pivoting member slidably disposed” within a “retaining cup”. These deficiencies are not overcome by the addition of Kessmar. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

New Claims

New claims 69-72 have been added in this Amendment for the Examiner’s consideration. The cited references, whether taken singularly or in any permissible combination, do not anticipate, teach or suggest the subject matter recited in new claims 69-72. In contrast to new claims 69-72, hood (4) of Blood (which the Examiner states corresponds to the “second element” of the pending claims), is not shown to include a first region that engages the ring member (4) (which the Examiner states corresponds to the “first element” of the pending claims), when lever (2) is pivoted to a first position, and which disengages ring member (4) when lever (2) is pivoted to a second position. Blood also does not describe hood (4) as having a second region that engages ring member (4) when lever (2) is pivoted to the second position, and disengages ring member (4) when lever (2) is pivoted to the first position. These deficiencies are not overcome by the addition of Kessmar. Thus, the Examiner’s consideration of new claims 69-72 is accordingly requested.

CONCLUSION

Reconsideration and allowance are respectfully requested. In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

It is believed no fees are due with this response. However, if any fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 66904-0001 from which the undersigned is authorized to draw. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 66904-0001 from which the undersigned is authorized to draw.

Dated: November 4, 2008

Respectfully submitted,

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